

STATUS OF CLAIMS

Claims 48-51 and 53-69 are pending in this application, claims 52 and 1-47 having been cancelled previously. Claims 48 and 66 are the independent claims.

REMARKS

Withdrawal of rejection under 35 USC 103(a)

Applicant acknowledges, with thanks, the withdrawal of the previous rejection of claims 48-51 and 53-65 under 35 USC 103(a) over AAPA, Hella and Freedenberg.

Nonstatutory Obviousness-Type Double Patenting Rejections

Claims 48-51 and 53-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,696,667 (Flanagan). A Terminal Disclaimer will be filed upon the indication of allowable subject matter.

Claims 66-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Flanagan in view of U.S. 5,620,318 (Freedenberg). A Terminal Disclaimer will be filed upon the indication of allowable subject matter.

Rejection of Claims 66-69 Under §102(b) and §103(a)

Claims 66-68 stand rejected under 35 U.S.C. §102(b) as being anticipated by Shapovalvo. Claims 66-68 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant's alleged admitted prior art (AAPA) in view of Shapovalvo. In addition, claim 69 stands rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of Shapovalvo and Freedenberg. These rejections are hereby traversed for the following reasons.

The Examiner states in the Final Action that

AAPA further teaches that the tube or stent (108) *may be rotated* via a rotational motor drive and linearly translated via linear motion (112), relative to a stationary laser source beam (see AAPA, specification, page 1, lines 10-12). Therefore one reading this cited portion would readily appreciate that rotation of the workpiece in AAPA is optional.

The portion of the specification cited by the Examiner states in full:

A typical laser arrangement is shown in Fig. 1. Laser 102 produces a beam 107 which is conditioned as necessary via optical unit 104 and focused into a spot beam which is impinged against hollow tube 108. Hollow tube 108 may be rotated via rotational motor drive 110 and linearly translated via linear motion drive 112.

Based on this language, rotation of the hollow tube is not mandatory. Notably, however, the cited passage does not indicate what results if the tube is not rotated. It simply states the self-evident fact the tube may or may not be rotated.

Independent claim 66 requires the radiation beam to be scanned about a circumference of the tubular workpiece *while the tubular workpiece remains stationary*. Claim 66 therefore requires the occurrence of a particular event while the workpiece remains stationary; namely, that the radiation beam be scanned about the circumference of the workpiece.

MPEP § 2121.01 states that in order for a cited art document to anticipate a claim, the cited art must provide an enabling disclosure of the claimed subject matter. This section of the MPEP goes on to state that the mere naming or description of the subject matter is insufficient; rather, the cited art must demonstrate that the public was in possession of the claimed subject matter before the date of invention. In other words, the cited art must describe the claimed subject matter in such detail as to enable one of ordinary skill in the art to make the claimed subject matter without undue experimentation.

In the present case, AAPA fails to enable one of ordinary skill in the art to make the claimed subject matter without undue experimentation. In fact, Applicant respectfully submits that one of ordinary skill could not scan the radiation beam about the hollow tube 108 shown in FIG. 1 without rotation of the workpiece. Thus, if the workpiece were to remain stationary as suggested by the Examiner, each and every limitation of the claim would not be met.

Shapovalvo is likewise a nonenabling disclosure without respect to the claimed subject matter for the same reasons as those presented above in connection with AAPA. In particular, the Examiner states in the Final Action that

Shapovalvo et al. applies the laser beam to cut a desired pattern in the stent preform by directing and redirecting the radiation beam (45a) by array of mirrors (column 3, lines 29-41); and states that the stent preform may be moved relative to the laser beam with the laser source being

stationary or the laser beam may be moved relative to the stent preform and scan about a circumference of the stent (see Shapovalvo et al. column 5, lines 32-47). Therefore option of the stent or workpiece being stationary is not excluded in Shapovalvo et al.

Like AAPA, movement of the stent or workpiece in Shapovalvo is not mandatory. Once again, however, Applicant respectfully submits that one of ordinary skill could not scan the radiation beam 45a about the workpiece 247 shown in FIG. 5 without rotation of the workpiece. As should be evident from FIG. 5 there is no apparent way that the optical beam emitted by nozzle 245 onto the workpiece 247 can be scanned about the workpiece's circumference without rotation of the workpiece. If the Examiner continues to maintain that the arrangement in Shapovalov has such a capability and is thus in fact an enabling disclosure, Applicant would appreciate it if the Examiner would elaborate on how this capability is achieved.

Since neither AAPA or Shapovalov, alone or in combination with one another or with Freedenberg, show or suggest a method in which the radiation beam is scanned about a circumference of the tubular workpiece while the tubular workpiece remains stationary, Applicant respectfully submits that the rejection of claims 66-69 under 35 U.S.C. 102(b) and/or 103(a) should be reconsidered and withdrawn.

Conclusion

In view of the foregoing, it is believed that the application is now in condition for allowance, and early passage of this case to issue is respectfully requested. If the Examiner believes there are still unresolved issues, a telephone call to the undersigned would be welcomed.

Respectfully submitted,

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